

Serial No. 09/863,078
February 4, 2004
Reply to the Office Action dated July 15, 2003
Page 6 of 9

REMARKS/ARGUMENTS

Claims 1-20 are pending in this application. The Examiner has withdrawn claims 4-7 and 14-17.

In the Advisory Action, the Examiner failed to specifically respond to any of Applicants' arguments presented in the Request for Reconsideration filed on December 10, 2003. Instead, the Examiner merely concluded that "the prior art of record discloses the claimed invention" without specifically addressing any of Applicants' arguments. Applicants respectfully request that the Examiner specifically respond to all of the arguments presented in the Request for Reconsideration filed on December 10, 2003, which are incorporated herein by reference, in response to this Request for Reconsideration.

Claims 1-3, 8-13, and 18-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants' Admitted Prior Art (AAPA) of Figure 5 in view of Wright (U.S. 3,548,356). Applicants respectfully traverse the rejection of claims 1-3, 8-13, and 18-20.

Claim 1 recites:

"A transformer comprising:
a bobbin having first and second tube-shaped members which are coaxial and integral with one another, said first tube-shaped member being located radially within said second tube-shaped member so as to form a gap located therebetween, and **said first and second tube-shaped members being integral with and attached to a common base member;**
a first winding comprising an air-core coil located in said gap between said first and second tube-shaped members of said bobbin;
and
a second winding affixed to said second tube-shaped member of said bobbin." (emphasis added)

The Examiner alleged in the first full paragraph on page 3 of the outstanding Office Action that it would have been obvious to make the first and second tube-shaped members integral with the common base member because "it has been held that

Serial No. 09/863,078
February 4, 2004
Reply to the Office Action dated July 15, 2003
Page 7 of 9

forming in one piece an article which has formerly been formed in two pieces and put together involves only routine experimentation. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893)."

As noted in the Request for Reconsideration filed on December 10, 2003, Applicants' claimed invention does not involve merely forming in one piece an article which has formerly been formed in two pieces. The structure and arrangement of elements recited in Applicants' claims 1 and 11 are completely different from that shown in Applicants' Fig. 5. Particularly, the first and second tube-shaped members of the present invention are integral with and attached to a common base member to provide a gap therebetween to accommodate an air-core coil. The transformer of AAPA as shown in Applicants' Fig. 5 does NOT include any gap or air-core coil. In contrast, as clearly seen in Applicants' Fig. 5, the coil 12 is formed by winding a wire around the tube-shaped member 11, and thus, certainly cannot be fairly construed as an air-core coil as recited in the present claimed invention.

Thus, contrary to the Examiner's allegations, Applicants' claimed invention does not merely involve forming into one piece an article which has formerly been formed in two pieces. Applicants' invention must be considered "as a whole". Medtronic, Inc., v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 220 USPQ 97, 99-100 (Fed. Cir. 1983). Rather than considering the invention "as a whole," the Examiner has improperly reduced Applicants' claimed invention to the "idea" of forming into one piece an article which has formerly been formed in two pieces. Reducing a claimed invention to an "idea" and then determining patentability of that "idea" is error. Jones v. Hardy, 727 F.2d 1524, 1528, 220 USPQ 1021, 1024 (Fed. Cir. 1984).

Second, assuming *arguendo* that the only difference between the prior art and Applicants' claimed invention is forming into one piece an article which has formerly been formed in two pieces, *Pyle Nat. Co. v. Lewin*, 92 F.2d 628 (7th Cir. 1937) states:

Appellants also advance the proposition that the mere casting together of two or more parts, which previously had been cast separately,

Serial No. 09/863,078
February 4, 2004
Reply to the Office Action dated July 15, 2003
Page 8 of 9

does not constitute invention, and a number of cases are cited in support of this contention, chief of which is *Howard v. Detroit Stove Works*, 150 U.S. 164, 14 S. Ct. 68, 37 L. Ed. 1039. This proposition, however, **must be limited to cases where by such a change no new or different result is attained.** (emphasis added)

Applicants have provided a copy of *Pyle* herewith for the Examiner's convenience. That is, making two parts integral has only been held to be obvious in the situations where doing so would result in no new or different result.

As noted above, Applicants clearly state in the last full paragraph on page 7 of the originally filed Specification that they have been able to provide a transformer which has improved coupling, reduced size, reduced tolerance for high voltages, and reduced cost. That is, Applicants have been able to provide a transformer with clearly different and greatly improved results.

Thus, Applicants' claimed invention is not obvious in view of the prior art because Applicants' claimed invention achieves different and improved results.

Wright was relied upon to allegedly teach an air-core coil. Wright certainly fails to teach or suggest "said first and second tube-shaped members being integral with and attached to a common base member" as recited in the present claimed invention. Thus, Applicants respectfully submit that Wright fails to cure the deficiencies of AAPA described above.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-3, 8-13, and 18-20 under 35 U.S.C. § 103(a) as being unpatentable over Applicants' Admitted Prior Art (AAPA) of Figure 5 in view of Wright (U.S. 3,548,356).

Accordingly, Applicants respectfully submit that -AAPA and Wright, applied alone or in combination, fail to teach or suggest the unique combination and arrangement of elements recited in claims 1 and 11 of the present application. Elected claims 2, 3, 8-10, 12, 13 and 18-20 depend upon claims 1 and 11 and are therefore allowable for at least the reasons that claims 1 and 11 are allowable.

Serial No. 09/863,078
February 4, 2004
Reply to the Office Action dated July 15, 2003
Page 9 of 9

In addition, since claims 1 and 11 are generic, Applicants respectfully submit that non-elected claims 4-7 and 14-17 are allowable for at least the reasons that claims 1 and 11 are allowance, and must be rejoined and allowed accordingly.

In view of the foregoing remarks and the remarks presented in the Request for Reconsideration filed on December 10, 2003, Applicants respectfully submit that this application is in condition for allowance. Favorable consideration and prompt allowance are solicited.

The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

Date: February 4, 2004


Attorneys for Applicants

Joseph R. Keating
Registration No. 37,368

Christopher A. Bennett
Registration No. 46,710

KEATING & BENNETT LLP
10400 Eaton Place, Suite 312
Fairfax, VA 22030
Telephone: (703) 385-5200
Facsimile: (703) 385-5080